

REMARKS

Claims 1-9, 11, 12, 18, and 19 remain in this application. Claims 1, 2, 7, and 9 have been amended. Claims 10, 13-17, and 20-22 have been canceled.

Restriction Requirement:

Election of claims 1-19, drawn to a method, is hereby confirmed. Unelected claims 20-22 have been canceled.

Objection to the Specification:

Paragraph [0015] was objected to. A replacement paragraph [0015], with markings to show the changes, has been provided.

Claim Rejections under 35 U.S.C. 102(e):

Claims 1, 4, 5, 8, 9, 11-13, 15, and 16 were rejected under 35 U.S.C. 102(e) as being anticipated by Kumamoto (U.S. Pub. 2003/0001283) (hereinafter “Kumamoto”).

Claim 1 has been amended to explicitly recite that no additional adhesive tape is applied in addition to the protective layer; thus, the protective layer is a “Combination Back Grind Tape and Underfill for Flip Chips” as is stated in the title. Kumamoto, in contrast, discloses use of adhesive back grind tape 510 in addition to coating 550’. Thus, Kumamoto fails to disclose each limitation of claim 1.

Claims 4, 5, 6, and 8 depend from claim 1. Kumamoto fails to disclose the limitations of these claims for the reasons provided above.

Claim 9 has been amended to recite that the protective layer comprises epoxy, which was formerly recited in claim 10. As claim 9 now includes the limitation of former claim 10, which was rejected under 35 U.S.C. 103(a), claim 9 is now discussed in the section on 35

U.S.C. 103(a) rejections, below. Claim 9 also recites a partial curing act and a further curing act for the protective layer.

Claims 11 and 12 depend from claim 9. Kumamoto fails to disclose the limitations of these claims for the reasons provided above.

Claim Rejections under 35 U.S.C. 103(a):

Each rejection under 35 U.S.C. 103(a) is based, at least in part, on the Kumamoto reference. Under 35 U.S.C. 103(c), these rejections should be withdrawn. Subject matter that qualifies as prior art only under 35 U.S.C. 102(e) does not preclude patentability if the reference and the application were, at the time the application was made, owned by the same person or subject to an obligation of assignment to the same person (35 U.S.C. 103(c)).

Kumamoto qualifies as prior art only under 35 U.S.C. 102(e). Kumamoto is assigned to the Intel Corporation, as recorded on October 23, 2001 at Reel 12277, Frame 0916. The present patent application is also assigned to the Intel Corporation, as recorded on December 11, 2003 at Reel 14799, Frame 0057, and under the inventor's employment agreement, was subject to an obligation of assignment to the Intel Corporation. Thus, under 35 U.S.C. 103(c), the rejections based at least in part on Kumamoto does not preclude patentability of the claims.

Claim 2 has been amended into independent form. The rejection of claim 2, which was a rejection under 35 U.S.C. 103(a) in part on Kumamoto, should be withdrawn under 35 U.S.C. 103(c). The rejection of claims 3 and 7, which depend from claim 2, should be withdrawn for the same reason.

Claim 9 was amended to include the limitation formerly recited in claim 10, which was rejected under 35 U.S.C. 103(a) based in part on Kumamoto. Under 35 U.S.C. 103(c), amended claim 9 should not be rejected under 35 U.S.C. 103(a) based in part on Kumamoto.

For the same reason, claims 11 and 12, which depend from claim 9, should not be rejected under 35 U.S.C. 103(a) based in part on Kumamoto.

Claim 18 was rejected under 35 U.S.C. 103(a), based at least in part on Kumamoto. As discussed above, this rejection should be withdrawn under 35 U.S.C. 103(c). The rejection of claim 19, which depends from claim 18, should be withdrawn for the same reason.

Respectfully submitted,

Date: November 21, 2006

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